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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,179

03/02/2004

Peter H. Sayet

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04/11/2007

AKERMAN SENTERFITT

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EXAMINER

NEAL, TIMOTHY J

ART UNIT

PAPER NUMBER

3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/791,179

Applicant(s)

SAYET, PETER H.

Examiner

Timothy J. Neal

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22, 25-41 and 43-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 44-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22, 25-41, 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This action is in response to the RCE filed on 3/12/2007.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 22, 25, 27, 28, and 32** are rejected under 35 U.S.C. 102(e) as being anticipated by Chao (US 6,869,438).

Chao discloses:

**22.** A non-invasive stomach stricture device, comprising: a front side member (Fig 3 Item 11); a backside member (Fig 3, item opposite 11); a connector (Fig 3 portion between 11 and opposite side) for coupling the front side member to the backside member to form a clamp, wherein the clamp has a size and shape for fitting adjacent to the trachea side of the upper quadrant of a stomach, with said

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front side member and said backside member forming a substantially continuous clamping of the stomach so as to form a canal within the stomach that is an extension of the esophageal canal for regulating nutrient absorption and caloric intake by reducing the capacity of the stomach (Fig 4), and wherein the backside member and the front side member include stomach contacting surfaces, the stomach contacting surfaces being free of piercing projections (Fig 3).

**25.** The device according to claim 24, wherein at least one of the stomach contacting surfaces include structure for permitting fluid flow (Fig 3).

**27.** The device according to claim 22, wherein the front side member, connector, and backside member are integral (Fig 3).

**28.** The device according to claim 22, wherein the backside member and the connector are integral (Fig 3).

**32.** The device according to claim 22, wherein the front side member and the backside member include an aperture through which the front side member and the backside member can be sutured to the stomach (Fig 4).

The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 22, 25, 26, and 28-32** are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins (US 4,458,681).

Hopkins discloses:

**22.** A non-invasive stomach stricture device, comprising: a front side member (Fig 1 Item 10); a backside member (Fig 1 Item 12); a connector (Fig 1 see marked drawing Item 1 from preceding Office action 9/12/2006) for coupling the front side member to the backside member to form a clamp, wherein the clamp has a size and shape for fitting adjacent to the trachea side of the upper quadrant of a stomach, with said front side member and said backside member forming a substantially continuous clamping of the stomach so as to form a canal within the stomach that is an extension of the esophageal canal for regulating nutrient absorption and caloric intake by reducing the capacity of the stomach (Fig 8), and wherein the backside member and the front side member include stomach contacting surfaces, the stomach contacting surfaces being free of piercing projections (Fig 1 Items 10 and 12).

**25.** The device according to claim 24, wherein at least one of the stomach contacting surfaces include structure for permitting fluid flow (Fig 1).

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**26.** The device according to claim 22, further comprising: a positioning member for coupling to the front side member and the backside member to form a clamping assembly (Fig 1 Item 22 on the right side of the figure).

**28.** The device according to claim 22, wherein the backside member and the connector are integral (Fig 1 Item 15).

**29.** The device according to claim 22, wherein the connector comprises a slot adapted to receive the front side member so that the front side member can be coupled to the backside member to form a clamp (Fig 1 Item 15).

**30.** The device according to claim 26, wherein the backside member and the front side member each comprise an anchoring slot, each anchoring slot adapted to receive an end of the positioning member (Fig 1 Items 14 and 15 on the right side of the figure).

**31.** The device according to claim 30, wherein each slot and the positioning member include corresponding engagement structure for coupling the positioning member to the front side member and the backside member (Fig 1 Items 14 and 15 and Item 22).

**32.** The device according to claim 22, wherein the front side member and the backside member include an aperture through which the front side member and

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the backside member can be sutured to the stomach (Fig 1 Items 14 and 15).

**Claims 22, 25, 27, 28, 32-35, 41, and 43** are rejected under 35

U.S.C. 102(b) as being anticipated by Ersek (US 4,378,802).

Ersek discloses substantially planar front and backside members (26 and 27), a connector (21), with the contacting surfaces of the members being free of piercing projections (see Figs 1-7). All other language of the independent claims is deemed functional language as to the location of the device during use. The Examiner considers the prior art capable of being placed at the claimed location. Therefore, the claims are not patentable over the prior art.

**Claims 22, 25, 26, 30-33, 35-41, and 43** are rejected under 35

U.S.C. 102(e) as being anticipated by Rennich (US 6,960,218).

Rennich discloses substantially planar front and backside members (12 and 14), a connector (24), with the contacting surfaces of the members being free of piercing projections (see Figs 1), a positioning member (26), anchoring slots (22), engagement structure (30), and an aperture (22). All other language of the independent claims is deemed functional language as to the location of the device during use. The Examiner considers the prior art capable of being placed at the claimed location. Therefore, the claims are not patentable over the prior art.

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**Claims 22, 25, 27, 28, 32-34, 41, and 43** are rejected under 35

U.S.C. 102(b) as being anticipated by Caserta (US 2,659,378).

Caserta discloses substantially planar front and backside members (17 and 13), a connector (11), with the contacting surfaces of the members being free of piercing projections (see Figs 1-4), and apertures (25). All other language of the independent claims is deemed functional language as to the location of the device during use. The Examiner considers the prior art capable of being placed at the claimed location. Therefore, the claims are not patentable over the prior art.

### ***Response to Arguments***

Applicant's arguments with respect to claims 33-43 have been considered but are moot in view of the new ground(s) of rejection.

The Applicant has argued that Chao and Hopkins do not disclose substantially planar front and backside members. The Examiner acknowledges the differences between the currently amended claims and the two references. The Examiner has removed the rejections, but notes that reinterpretation of the art at a later time is not out of the question. References Caserta, Rennich, and Ersek have been added to more clearly anticipate the current claims, specifically the substantially planar front and backside members. The placement of the device in relation to particular anatomy is considered functional. The prior art is capable of being placed at the claimed location. Therefore, the claims are not patentable over the referenced prior art.



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Neal whose telephone number is (571) 272-0625. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJN

  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**  
4/2/07